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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/617,580 | 07/11/2003 | Thomas L. Foster | 10922/51 | 3677 |
| 757 | 7590 | 12/14/2007 | EXAMINER | |
| BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610 | | | NGUYEN, TUAN VAN | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3731 | | |
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| | | 12/14/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|-----------------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/617,580 | FOSTER ET AL. |
| | Examiner Tuan V. Nguyen | Art Unit 3731 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 September 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
 - 4a) Of the above claim(s) 9,23 and 27-29 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8,10-22 and 24-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/28/07, 12/21/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 21, 2006 has been entered.

Response to Restriction Requirement

2. According to the Response to Restriction Requirement applicant filed on September 28, 2007, applicants elect without traverse the invention of claims 1-26 that are drawn to a cannula device and further elect without traverse Species I of Figs. 1-6. Claims 9, 23 and 27-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

Response to Amendment

3. Applicant's arguments filed on December 21, 2006 with respect to claims 1-29 have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (U.S. 5,843,050).**
6. Jones discloses (see Fig. 3) a polymer mircrocatheter 10 having tubular element 30 wherein a distal portion of tubular 30 includes at least two sections with spiral cut wherein spiral cut of each section having different pitch to provide a high degree of flexibility to facilitate negotiation of small, tortuous vessels (see Abstract and col. 5, lines 1-40).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 2, 5, 6, 15-17, 22 and 25-26 are rejected under 35 U.S.C. 103(a) as being obvious over Jones et al (U.S. 5,843,050).**

10. Referring to claims 2, 5, 6, 15-17, 22, and 25-26, the device of Jones discloses the invention substantially as claimed except for specifically disclosing the dimensions that claimed by the applicant. It would have been obvious to one having ordinary skill in the art to design the spiral cut is taken about 60 to about 80 degrees from the longitudinal axis of the cannula and the width of the spiral cut is about 0.001 to about 0.002 inches wide, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Extrinsic evidence; Pinchuk (US 4,960,410) discloses spiral cut is taken about 25 to about 85 degrees from the longitudinal axis of the cannula (see col. 3, lines 58-60).

11. **Claims 3, 4, 7, 12-14, 18-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (U.S. 5,843,050) in view of Sachdeva et al (U.S. 5,885,258).**

12. Referring to claims **3, 4, 7, 13-14 and 18-21**, Jones discloses the invention substantially as claimed except for a tool or grasper is disposed on the distal portion of the cannula wherein the grasper and the cannula is a unitary component. However, Sachdeva disclose such a tool or grasper wherein the grasper and the cannula is a unitary component. Sachdeva discloses (see Figs. 1A-1D and 6A) a retrieval device made from shape-memory alloy comprising: a cannula 11 comprising a proximal portion; a distal portion; a grasper portion, which includes plurality of slots 12, located at the distal portion of the cannula 11; and a sheath 13 for controlling the grasper portion. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the retrieve device as disclosed by Sachdeva into the distal end of the device of Jones to further utilizing the device of Jones as a retrieval basket for small particles in an organ or vessels as suggested by Sachdeva.
13. Referring to claims **12 and 24**, the modified device of Jones discloses the invention substantially as claimed except for the grasper is not a part of the continuum of material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the grasper is a separated component with the cannula, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

14. **Claims 10, 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al in view of Sachdeva et al as applied to claims 1 and 15 above and further in view of DeCastro et al (US 4,899,733).**
15. The modified device of Jones discloses the invention substantially as claimed except for the device further comprising ureteroscope comprising an optical fiber and an irrigation system a laser fiber within the cannula. However, DeCastro discloses such a system. DeCastro discloses (see Figs. I-IV) an ureteroscope comprising one or more lumen 10 for insertion of an optical system 12, wave guide 4, and irrigation fluid. Apparently the ureteroscope of DeCastro provides surgeon the ability to break large stone into small pieces under direct visual control of the surgeon (see col. 1, lines 62-65), therefore, it would have been obvious to one of ordinary skill in the art to incorporate the system of DeCastro into the modified device of Jones so that it too would have the same advantage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
December 8, 2007


ANHTUANT. NGUYEN
SUPERVISORY PATENT EXAMINER

12/10/07.